

Application No. 09/872,036  
Amendment Dated November 8, 2004  
Reply to Office Action of May 7, 2004

### **REMARKS/ARGUMENTS**

By this Amendment, the specification is amended, Claims 1 and 15-16 are cancelled, Claims 2-14 and 17-20 are amended and Claim 21 is added.

The Applicants acknowledge the courtesies extended during the interview of October 7, 2004.

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

The Examiner sets forth that this application claims priority as a division of U.S. Application No. 09/723,505, filed November 28, 2000 and that a later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in an earlier or parent application is known as a divisional or "division." The Examiner further sets forth that the divisional application should set forth only that portion of the earlier disclosure which is germane to the invention as claimed in the divisional application, but that this application repeats a substantial portion of prior application No. 09/723,505, filed November 28, 2000 and adds and claims additional disclosure not presented in the prior application. Therefore, the Examiner believes that it may constitute a continuation-in-part of the prior application, but does not appear to be a division and that should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

The Applicant sets forth that the present application is a divisional of Application Serial No. 09/723,505, filed on November 28, 2000 entitled "Method and System for

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Creating and Displaying Images Including Pop-Up Images on a Visual Display” as set forth on page 2 of the instant application. Application No. 09/723,505 claims priority from a provisional application Serial No. 60/201,970, filed May 5, 2000, entitled “Method and System for Providing Links to Websites Via Banner Advertisements”. In addition to claiming priority of provisional application, application No. 09/723,505 added and claimed new matter. The instant application added no new matter beyond subject matter filed with application No. 09/723,505.

The Examiner further sets forth that Claims 1-20 are provisionally rejected under the judicial created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-18 of co-pending application 09/872,072. Although the Examiner believes that the conflicting claims are not identical, the Examiner further believes that they are not patentably distinct from each other because Claims 1-18 of the co-pending application provides substantially the same limitations as those in Claims 1-20 of the instant application, except that the instant application substitutes a “a primary area” with a “banner area”. The Examiner further sets forth that it would have been obvious to one of ordinary skill in the art to use the primary area of the co-pending application as a banner area in order to provide advertisements in the display. Claim 14 of the co-pending application describes the altering of associations in part © of Claim 1 according to the Examiner.

The Examiner further sets forth that this is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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In response, the Applicants submit that a Terminal Disclaimer will be provided when allowable subject matter over the cited references is found by the Examiner.

The Applicants' representative gratefully acknowledges the courtesies extended by the Examiner during the telephone interview granted by the Examiner and the Personal Interview granted on October 7, 2004. The Applicants' separate description of matters discussed is incorporated herein.

The Examiner sets forth that Claims 1, 7-8, 11-15 and 19-20 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,370,537 to Gilbert et al. (hereinafter Gilbert).

Referring to Claim 1, the Examiner sets forth that Gilbert discloses a method for delivering information to a person accessing a banner website from a terminal located remote from a source of the banner website, the terminal having an associated display upon which a content of the website is visually perceived by a person using the terminal and a cursor whose position is controllable by the person. The Examiner directs the Applicants' attention to col. 17, lines 12-30, which describe how the banner is determined by an ad server, which is remote from the user's terminal. According to the Examiner, Fig. 26 shows a website, whose content is visually perceived by the user, with banner 2600. The Examiner directs the Applicants' attention to col. 17, lines 44-47 which the Examiner believes describes how the user may move the mouse, which controls the position of a cursor.

a) The Examiner further sets forth that the method of Gilbert provides initial signals from the source of the website or from another remote source when the website is accessed by the person to establish a banner area on the display (the Examiner directs the Applicants' attention to col. 17, lines 12-21), the banner area including banner information that the Examiner believes is visually perceivable by the person when the website is accessed and plural sub-areas of the banner area. The Examiner directs the Applicants' attention to Fig. 26, banner 2600, which the Examiner believes shows three sub-areas (frames). Also, the Examiner directs the Applicants' attention to col. 17, lines 40-44, which the Examiner believes describes how the banner may be split into frames. The sub-areas have respective associations with additional visually perceivable information (pop-up advertisement) according to the Examiner. The Examiner directs the Applicants' attention to Fig. 26 and col. 17, lines 17-31 and 50-54, which the Examiner believes describes how the content of the pop-up (additional visually perceivable information) and banner are determined by the ad server and may be changed by the advertiser.

b) According to the Examiner, the method of Gilbert enables the person to select any one of the sub-areas of the banner area to provide a selected sub-area, whereupon the person is provided with a first display of the respective additional visually perceivable information associated with the selected sub-area. The Examiner directs the Applicants' attention to col. 17, lines 44-53, which the Examiner believes describes how a mouse over an image in one of the frames causes a pop-up window (visually perceivable) to be displayed in a specific region of the display, the Examiner further believes that the pop-up

window provides additional advertising message information associated with the selected sub-area (frame).

c-d) The Examiner further sets forth that the method of Gilbert alters the association between additional visually perceivable information and the sub-areas (frames) to provide reassociated information and provides a second display of the reassociated information. The Examiner directs the Applicants' attention to col. 17, lines 17-31 and 50-54, which the Examiner believes describes how the content of the pop-up (additional visually perceivable information) and banner are determined by the ad server and may be changed by the advertiser.

Referring to Claims 7-8, the Examiner sets forth that the initial signals of Gilbert carry the instructions necessary for enabling the terminal to establish the additional visually perceivable advertising message information (pop-up) when in receipt of appropriate data and when the instructions operate upon the appropriate data, and the Examiner further sets forth that the method of Gilbert re-accesses the source of the website or accesses another source for receiving the appropriate data upon which the instructions operate to provide the additional visually perceivable information. The Examiner directs the Applicants' attention to col. 17, lines 25-31 and 50-54.

Referring to Claims 11-12, the Examiner sets forth that the method of Gilbert receives the visually perceivable banner information, first identification data representative of the visually perceivable banner information, the additional visually perceivable information and second identification data representative of additional visually perceivable

information according to the Examiner. The Examiner directs the Applicants' attention to col. 17, lines 25-31 and 50-54, which the Examiner believes describes how the banner information and additional information are served from an ad server, and therefore must be received by the terminal. The method of Gilbert specifies a placement of the additional visually perceivable information with respect to the visually perceivable banner information according to the first and second identification data according to the Examiner. The Examiner further directs the Applicants' attention to Fig. 26, which the Examiner believes shows the pop-up window (additional information) in relation to the banner.

Referring to Claim 13, the Examiner sets forth that the method of Gilbert must build a use map in accordance with the first and second identification data to associate the appropriate pop-up window with the appropriate image (sub-area) in the banner. The Examiner directs the Applicants' attention to col. 17, lines 44-47. Also, the Examiner directs the Applicants' attention to col. 12, lines 20-28.

Referring to Claim 14, the Examiner sets forth that Gilbert discloses that the step of providing additional visually perceivable information comprises the steps of:

a) building a pop-up function in accordance with the additional visually perceivable information (the Examiner directs the Applicants' attention to col. 17, lines 44-47);

b) adding HTML information to the pop-up function to provide an enhanced pop-up function (the Examiner directs the Applicants' attention to col. 17, lines 47-50 and col. 12, lines 26-28); and

c) displaying the visually perceivable banner information and the additional perceivable information in accordance with the enhanced pop-up function. The Examiner further directs the Applicants' attention to col. 17, lines 40-50 and the pop-up associated with banner 2600 in Fig. 26.

Referring to Claim 15, the Examiner sets forth that Gilbert discloses repeating step (b) after the step of altering associations between the sub-areas (frames) and the respective additional visually perceivable information. The Examiner directs the Applicants' attention to col. 17, lines 17-31 and 50-54, which the Examiner believes describes how the content of the pop-up (additional visually perceivable information) and banner are determined by the ad server and may be changed by the advertiser.

Referring to Claim 19, the Examiner sets forth that Gilbert discloses transmitting a request having request information to a server database (ad server) on a website containing stored visually perceivable information in response to the positioning of the cursor on the selected sub-area (frame), selecting the additional visually perceivable information (pop-up window) from the stored visual information in response to the request information, and transmitting the stored visually perceivable information to the banner website. The Examiner directs the Applicants' attention to col. 17, lines 44-54.

Referring to Claim 20, the Examiner sets forth that the terminal of Gilbert provides a terminal display having a display iframe comprising the steps of displaying the additional visually perceivable banner information within the display iframe and displaying the additional visually perceivable advertising message information in response to positioning

the cursor on the iframe. The Examiner directs the Applicants' attention to col. 17, lines 12-47 and Fig. 26.

Claims 2, 6 and 9-10 are rejected under 35 U.S.C. 103(a) being unpatentable over Gilbert.

Referring to Claim 2, the Examiner sets forth that Gilbert shows a pop-up window associated with banner 2600 in Fig. 26, which substantially crosses the lower boundary of the banner area, but the Examiner believes that Gilbert does not explicitly show the selected region where the pop-up window (visually perceivable information) is displayed is provided substantially outside the boundaries of the banner area. However, the Examiner believes that pop-up windows may be placed anywhere within a display and may comprise different sizes. As an example, the Examiner directs the Applicants' attention to Fig. 18 or the Examiner further sets forth that Gilbert, which the Examiner believes shows a pop-up window (1802), provided substantially outside of the boundaries of banner area (1801). According to the Examiner, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the pop-up window of Gilbert in a selected region provided substantially outside of the boundaries of the banner area, in order to prevent covering up the banner, and reducing its visibility or to enlarge the pop-up window to draw attention to it.

Referring to Claim 6, the Examiner sets forth that the additional visually perceivable information (pop-up) of Gilbert is imperceivable by the person until the cursor is located on the selected sub-area. The Examiner directs the Applicants' attention to col. 17, lines 44-



53, which the Examiner believes describes how a mouse over an image in one of the frames causes a pop-up window (visually perceivable) to be displayed, which provides additional information associated with the selected sub-area (frame) the Examiner believes that the Examiner believes that the pop-up window does not have a button in the window for closing the window ('x'), and therefore it is believed by the Examiner to remain perceivable to the person as long as the cursor remains on the selected sub-area (frame) or on the pop-up window. The Examiner believes that it is typical for a mouse over event to last as long as the mouse (cursor) remains positioned over the image associated with the mouse over. The Examiner takes Official Notice of this teaching. The Examiner sets forth that it would have been obvious to one of ordinary skill in the art to ensure the pop-up window of Gilbert remains open as long as the cursor remains on the selected sub-area (frame) or the pop-up window (region), because the Examiner further sets forth that the lack of movement of the cursor indicates the user is still reading the additional information.

The Applicants respectfully traverse the Examiner's Official Notice.

Referring to Claim 9, the Examiner sets forth that the pop-up window of Gilbert (additional visually perceivable information) is displayed in a region (window) adjacent to the selected sub-area (frame). The Examiner directs the Applicants' attention to the pop-up window over (adjacent) the banner 2600 in Fig. 26. The pop-up window does not have a button in the window for closing the window ('x') the Examiner believes, and therefore the Examiner believes it remains perceivable to the person as long as the cursor remains on the selected sub-area (frame) or on the pop-up window. The Examiner further believes

that it is typical for a mouse over event to last as long as the mouse (cursor) remains positioned over the image associated with the mouse over. The Examiner takes Official Notice of this teaching. The Examiner sets forth that it would have been obvious to one of ordinary skill in the art to ensure the pop-up window of Gilbert remains open as long as the cursor remains on the selected sub-area (frame) of the pop-up window (region), because the lack of movement of the cursor indicates the user is still reading the additional information.

The Applicants respectfully traverse the Examiner's Official Notice.

Referring to Claim 10, the Examiner sets forth that the additional visually perceivable information (pop-up) of Gilbert contains link information for linking the person to a further website when the person clicks on the selected region. The Examiner directs the Applicants' attention to col. 17, lines 48-64.

The Examiner further sets forth that Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert and U.S. Patent No. 6,496,857 to Dustin et al. (hereinafter Dustin).

Referring to Claims 3-5, the Examiner believes that Gilbert discloses additional visually perceivable information in the form of a pop-up window, but the Examiner believes that Gilbert does not explicitly describe that the pop-up window contains audio information, video information, or mixed media information according to the Examiner. However, according to the Examiner, Dustin describes a method for enhancing advertisements, which provides ads that contain audio, video, and/or mixed media information. The

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Examiner directs the Applicants' attention to col. 3, lines 5-8. According to the Examiner it would have been obvious to one of ordinary skill in the art at the time of the invention to enhance the additional visually perceivable advertising message information (pop-up window advertisements) of Gilbert such that they include audio, video, and/or mixed media information for a more affective form of advertisement as supported by Dustin.

The Examiner sets forth that Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert and U.S. Patent No. 6,401,075 to Mason et al. (hereinafter Mason).

Referring to Claims 16-18, the Examiner sets forth that Gilbert discloses that the advertisements may be customized according to a user profile or at the discretion of the advertiser (the Examiner directs the Applicants' attention to col. 17, lines 21-31), but the Examiner believes that Gilbert does not explicitly teach altering the association between the sub-areas and the respective additional visually perceivable information (pop-up advertisements) in accordance with recorded performance parameters. However, the Examiner believes that Mason discloses methods of monitoring internet advertising in which parameters (which are predetermined) representative of the advertisements (i.e. click-through) are recorded to provide recorded performance parameters, and the Examiner believes that the advertisement presented are altered in accordance with the recorded performance parameters. The Examiner directs the Applicants' attention to col. 2, lines 39-51. Altering the advertisements in accordance with the recorded performance parameters is repeated to provide the advertiser with accurate results of the success of the

advertisements the Examiner believes. The recorded performance characters may be selected after altering the associations according to the Examiner. The Examiner directs the Applicants' attention to Mason at col. 4, lines 20-37 and col. 6, lines 51-65. The Examiner further believes that it would have been obvious to one of ordinary skill in the art to modify the associations between the frames of the banner (sub-areas) and the pop-up window (additional visually perceivable advertising message information) of Gilbert in accordance with recorded performance parameters as taught by Mason in order to provide the advertiser with information on the success of the advertisements in the pop-up window and alter the pop-up window and banner accordingly as supported by Mason.

#### **Applicants' Invention**

The Applicants' system delivers advertising messages to a person accessing a banner website from a terminal located remote from the source of the banner website. Initial signals are provided from the source when the website is accessed by the user to establish a banner area on the display panel. The Applicants' banner area includes banner information that is visually perceivable by the person when the website is accessed. Additionally, the banner area includes plural sub-areas, wherein each of the sub-areas is formed from the same set of initial signals as the image in the banner area.

Additional visually perceivable images are associated with the banner sub-areas to provide a first set of associations between the sub-areas and the additional images. Performance parameters are monitored and optimized. The associations between the sub-areas and the images are altered to provide a second set of associations between the sub-

areas and the images. In this manner, the additional visually perceivable information can be moved to and associated with different positions on the overall banner display area to find its optimum locations. This process can be repeated using differing optimization criteria.

Therefore, the Applicants' new Claim 21 sets forth a method for delivering information to a person accessing a banner website from a terminal located remote from the source of the banner website, the terminal having an associated display device upon which the content of the website is visually perceived by a person using the terminal and a cursor whose position is controllable by the person. The method includes serving initial signals from the source of the website or from another remote source by means of Javascript when the website is accessed by the person to provide a banner display of a banner area, the banner display having a display on the display device during a display time period. The banner display area includes a plurality of banner sub-areas formed from the serving of initial signals and banner advertising message information that is visually perceivable by the person during the display time period when the website is accessed.

A plurality of additional visually perceivable images is provided, each banner sub-area being associated with an additional visually perceivable image of the plurality of additional visual images to provide a set of associations between the banner sub-areas and the additional visually perceivable images. The set of associations during the display time period and the person is enabled to select one of the banner sub-areas of the banner

display to provide a selected banner sub-area, whereupon the person is provided by means of Javascript with a display of selected additional visually perceivable advertising message information associated with the selected banner sub-area in accordance with the set of associations during the display time period. Parameters representative of the performance of the additional visually perceivable images are recorded to provide recorded performance parameters, and at least one parameter is optimized in accordance with optimization criteria and the recorded performance parameters to provide optimized parameter information.

The associations between the banner sub-areas and the associated additional visually perceivable images within the set of associations are altered in accordance with the optimized advertisement information to provide a second set of associations between the banner sub areas and the additional visually perceivable images, the second set of associations differing from the set of associations. The second set of associations is maintained during the second display time duration. Steps (a) to (g) are repeated using the same additional visually perceivable images and differing optimization criteria to provide differing sets of associations between the banner sub-areas and the additional visual images during differing display time periods.

#### **Applicants' Discussion of the Prior Art**

Mason teaches a method for obtaining an advertisement, modifying the advertisement to fit designated spaces for differing web sites, and placing the differing advertisements at the differing web sites. In the method taught by Mason, an original

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advertisement is loaded into a central processor and used to form derivative advertisements that conform to the configuration parameters of a plurality of selected web sites. The properly configured derivative advertisements are then transmitted to their corresponding web sites. Parameters such as the number of hits or click throughs obtained by the advertisements are monitored. The banners at the website can be altered according to the information obtained by monitoring the click throughs.

However, Mason teaches the associating and the altering of an association between an advertisement and an entire banner area. Mason does not teach the association of additional visually perceivable images with individual banner sub-areas when a user positions the cursor on a sub-area as defined in Claim 21.

Applicants strongly traverse the Examiner's suggestion during the October 7, 2004 interview that a plurality of banners as taught by Mason, when moved to positions adjacent to each other to form a single large banner, suggests the Applicants' banner sub-areas. As defined in new Claim 21 all of the sub-areas of the Applicants' banner are formed from a single serving of initial signals. Mason teaches forming a plurality of banners, each with its own set of initial signals. Mason does not each obtaining information for all of the "sub-areas" within the composite "banner" suggested by the Examiner from the same initial signals.

Therefore, if the banners of Mason are placed in adjacent positions, the sub-regions suggested by the Examiner would not have the same set of initial signals and would not be a banner as defined in Claim 21. Thus, Mason does not teach or suggest serving initial

signal to provide a banner displaying of a banner area including a plurality of banner sub-  
areas formed from said serving of initial signals as required by the Applicants' new Claim  
21.

Furthermore, Mason does not teach providing differing sets of associations with the  
in accordance with same additional visually perceivable images from a single initial serving  
and differing optimization criteria as required by Claim 21. Mason is silent with respect to  
rearranging the same pop up images on a single banner according to differing optimization  
criteria.

Gilbert teaches projects which include a meta object layout and a number of meta  
objects, wherein meta layouts contain the mapping information of the meta objects. The  
meta objects contain linked nodes of a hierarchal data structure and the mapping  
information is used for mapping the meta objects to the display. Queries taught by Gilbert  
retrieve projects, and thereby the meta objects within them. They are adapted to return  
data as query results which are then passed to the display.

The information of Gilbert may be rendered in frames, each frame representing a  
different product, and those products can revolve across the viewer's webpage in the  
banner space provided. As the user moves a mouse over the images rotating across the  
field a pop-up window will appear, giving more information about a particular product. See  
17:40-47. Thus, after the initial signals are served in Gilbert the rotating image is  
associated with differing regions of the banner during the display. Therefore, the



associations between the rotating icon and the various regions of the banner are not maintained constant during that serving of the initial signals.

Accordingly, Gilbert does not teach associating an image with an area of a banner and maintaining the association during the display of a serving of initial signals as required in new Claim 21. New Claim 21 requires the associations to be maintained during a first serving, reassociated, and then maintained during a second serving of initial signals. Furthermore, Gilbert does not teach measuring or optimizing parameters and reassociating images accordingly as recited in new Claim 21. It follows that Gilbert does not teach optimizing according to differing optimization criteria during differing servings of initial signals.

Additionally, Gilbert does not teach or suggests first serving initial signals to provide a manner display of a banner area on a display device, the display area including a plurality of banner sub-areas formed from the serving of initial signals is required in Applicants' new Claim 21.

Dustin teaches delivering targeted enhanced advertisements across electronic networks. In the system taught by Dustin equipment at the user site sends a notification when the user clicks on a specific portion of a displayed advertisement. In response to the clicking on the advertisement an enhanced version of the advertisement is accessed. At a later time, the user can request access to the enhanced information. In one embodiment of the system taught by Dustin a stream of thumbnails of enhanced versions of the information can be displayed on the user's screen. However, the thumbnails are

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transmitted in response to clicking on a specified designation within the banner, rather than in response to merely navigating to one of a plurality sub-areas in the banner. Selected thumbnails within the plurality of thumbnails can be enlarged by navigating to them.

Furthermore, none of the references cited by the Examiner teach or suggest providing initial signals by means of Javascript, providing additional visually perceivable advertising message information by means of Javascript establishing a banner area on a terminal by means of Javascript, or removing an enabled image by means of Javascript as required by new Claim 21.

For at least the reasons set forth above, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,  
COHEN & POKOTILOW, LTD.

November 8, 2004

Please charge or credit our Account  
No. 03-0075 as necessary to effect  
entry and/or ensure consideration of  
this submission.

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